

## REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

### Status of the Claims

Claims 1 and 3 are amended. Claims 2, 4, 7 and 10 are cancelled, without prejudice or disclaimer. Claims 15-16 are added. Support for the features of claims 15 and 16 can be found in the Original Specification, for example at, page 15 line 27 to page 16, line 2.

### Claim Rejections – 35 USC §112

Claims 7 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claims 7 and 10 are cancelled without prejudice or disclaimer in order to further prosecution.

### Claim Rejections – 35 USC §102(e)

Claims 1, 3, 6, 7, and 9-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Kobayashi (U.S. Patent No. 6,601,289). The rejection with regard to claims 7 and 10 are moot since they are cancelled. The rejection with regard to claims 1, 3, 6, 9 and 11-14 is respectfully traversed.

Claims 1 and 3, as amended, *inter alia* recite, a method of manufacturing a superconducting wire, that comprises, maintaining the temperature of said wire at a substantially constant temperature between greater than or equal to 80 °C and less than or equal to 300 °C during the at least one interval. Kobayashi fails to disclose at least the above recited feature. Instead, as acknowledged in the Office Action of January 22, 2009, Kobayashi “discusses the gradual increasing of temperature”. (Office Action, Page 3; Kobayashi, col. 18, ll. 26-52) In particular, Kobayashi teaches heat treatment at a first temperature of 840°C for 50 hours and teaches a second heat treatment at a temperature of 835°C. (Kobayashi, col. 18, ll. 15-25; see Table 1) The method is Kobayashi discloses

increasing the temperature through 100°C to 300°C range in order to get to 840°C. (Kobayashi, col. 18, ll. 15-25; see Table 1) Thus, Kobayashi fails to disclose, maintaining the temperature of said wire at a substantially constant temperature.

Kobayashi fails to anticipate at least the above recited features of claims 1 and 3. Therefore claims 1 and 3 are believed to be allowable. Because claims 3, 6, 9 and 11-14 depend, directly or indirectly, from either claim 1 or 3, they are believed to be allowable for at least the same reasons claims 1 and 3 are believed to be allowable.

Claim Rejections – 35 USC §103

Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi. This rejection is respectfully traversed.

The present application (U.S. Patent App. No. 10/569,829) and the Kobayashi (U.S. Patent No. 6,601,289) were, at the time the invention of the present application was made, owned by, or subject to an obligation of assignment to, Sumitomo Electric Industries, LTD. Attached, as Exhibit 1, is a copy of an assignment recorded on March 29, 2006, at reel/frame 017405 / 0168, assigning the above-identified patent application (U.S. Patent App. No. 10/569,829) from the inventors to Sumitomo Electric Industries, LTD.

Attached, as Exhibit 2, is a copy of an assignment recorded on April 27, 2000, at reel / frame 010754 / 0864, assigning U.S. Patent App. No. 09/559,377 (Kobayashi, U.S. Patent No. 6,601,289) and all continuation-in-part applications of that application from the inventors of that application to Sumitomo Electric Industries, LTD.

Due to the common ownership, the Kobayashi reference (U.S. Patent No. 6,601,289) is **disqualified** as prior art under 35 U.S.C. 103(c) with respect to the present application for the rejections under 35 U.S.C. 103(a). Therefore, independent claim 1, as amended, is believed to be allowable.

### Double Patenting

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of copending Application No. 10/568,537. Applicants respectfully traverse the rejection due to patentable distinctions between the claims of the present application and the cited claim 3 of copending Application No. 10/568,537. In addition, a Terminal Disclaimer is also submitted herewith to overcome the rejection. Accordingly, the rejection of claim 1 is respectfully traversed.

### New Claims

New claims 15 and 16 are added to further protect aspects of the present invention. New claims 15 and 16 are supported by the present disclosure, at least with respect to claims 15 and 16. (Page 15, line 27 to page 16, line 2) New claims 15 and 16, depend from independent claims 1 and 3, respectively. Accordingly, each of the new claims 15 and 16 are patentably distinguishable over the references of record, at least for reasons as discussed above with respect to claims 1 and 3. In addition each new claim 15 and 16 are further distinguished from the references of record.

For example, new claims 15 and 16 are dependent on claims 1, and 3, respectively, and incorporate every feature of the parent claims and further recite, the at least one interval is three days; wherein maintaining the temperature of the wire at a substantially constant temperature during the at least one interval occurs for three days. As discussed above regarding claims 1 and 3, Kobayashi fails to teach, suggest or render predictable maintaining the temperature of the wire at a substantially constant temperature. Kobayashi also fail to disclose, maintaining the temperature of the wire at a substantially constant temperature during the at least one interval occurs for three days. Therefore claims 15 and 16 are believed to be allowable.

### Concluding Remarks

After amending the claims as set forth above, claims 1, 3, 5, 6, 8, 9 and 11-16 are pending in this application.

Applicants believe that the present application is in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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